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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,477	10/08/2003	Jianhua Mao	U 0194 NHG/VEPT	7486

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COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,477

Applicant(s)

MAO, JIANHUA

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1 and 3-9 is/are allowed.
- 6) Claim(s) 2 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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Claims 1-9 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "comprises" line 2, renders the claim indefinite. The term is an open-ended term, which cannot be used in reference to a compound (succinic acid). By replacing the term with "is" the rejection would be overcome.

Applicant was contacted to authorize above amendment but decline to do so. Applicant asserts that the term is meant to embrace "one or more" succinic acid. This assertion, the Examiner pointed out, is not in accordance with claim 1 from which claim 2 depends. Claim 1 recites "a tocopherol dibasic acid hemiester starting material", which implies one starting material, not "one or more". Applicant argues that this language of claim 1 means "one or more starting material" and therefore, claim 2 properly depend from claim 1. Applicant further argues that several court decisions interpret "a" or "an" as meaning "one or more", citing *In re KCJ Corp v. Kinetics Concepts, Inc*, 55 USPQ2d 1835 (CAFC, 2000), where the court held as follows:

Indefinite article "a" or "an" in patent parlance carries meaning of "one or more" in open-ended claims containing transitional phrase "comprising," and unless claim is specific as to number of elements, article "a" receives singular interpretation only in rare circumstances when patentee evinces clear intent to so limit article; if claim language or context suggests ambiguity in application of general meaning of article, then court

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must undertake examination of written description and prosecution history to ascertain whether to limit meaning of "a" or "an."

In that case the claim recites, "An air flotation, ventilated mattress apparatus comprising . . ." Clearly, "An" is modified by "comprising" in the claim language hence, the court's holding. In the instant case, "a tocopherol dibasic acid hemiester starting material" is not modified by any open-ended term. Applicant asserts that comprising in line 2 of claim 1 applies to the starting material recite in line 3. This is not persuasive because comprising in line 2 of the claim modifies only the term "method" in line 1, not the "a" in line 3.

Additionally, the instant invention is direct to making a single product. There is indication in the specification or other claims that the invention is for making a plurality of compounds or combinatorial of compounds in a single procedure. Therefore, the process must require a single starting material, which may be one of several applicable starting materials.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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A handwritten signature in black ink, appearing to read 'Tafiq Solola', written in a cursive style.

TAFIQ SOLOLA
PRIMARY EXAMINER

Group 1626

September 1, 2004